

REMARKS

Applicants respectfully request reconsideration and allowance of all pending claims.

I. Status of the Claims

Upon entry of this Letter, claims 1, 2, 4, 7, 8, 12-16, 19, 24, 27, 29-31, 38, 41, 42, 45-47, 49, 51, 52, 56, 59, 64 and 164 are currently pending. No claims have been amended herein.

II. Election/Restriction

Applicants hereby acknowledge the Office's removal of the previous restriction requirement.

III. 35 U.S.C. 102(e)/103(a) Rejections

Reconsideration is requested of the rejection under 35 U.S.C. 102(e), or, in the alternative, § 103 (a) of claims 1, 2, 4, 7, 8, 12-16, 19, 24, 27, 29-31, 38, 41, 42, 46, 47, 49, 51, 52, 56, 59, 64 and 164 as being anticipated by, or, in the alternative, as obvious over Yamaki, et al. (U.S. 2004/0202933 A1).

A. The Claimed Subject Matter

The present application discloses an electrochemical cell directed toward improving the discharge efficiency of batteries and designed for better cathode utilization without increasing the potential for significant cell gassing (see paragraphs

[0009]-[00010] of the specification). More particularly, claim 1 is directed to, in relevant part (emphasis added):

an electrochemical cell that comprises:
a container defining a positive cell terminal end and a negative cell terminal end;
a cathode disposed in the container and including a primary active material;
an extender **different from the primary active material** and present in an amount no greater than that of the primary active material, wherein the extender has a discharge voltage lower than an initial discharge voltage of the primary active material;
an anode including an anode material disposed in the container adjacent the cathode; and
at least one separator disposed between the anode and cathode, and further disposed between the anode and extender.

B. Yamaki, et al.

Yamaki, et al. disclose a lithium secondary battery that uses a cathode active material comprising a composite oxide of lithium and a transition metal such as Mn, Co or Ni for a cathode, a lithium intercalating anode active material mainly comprising carbon, and a non-aqueous electrolyte having lithium ions for electrochemically bonding the cathode and anode.

C. The Claimed Subject Matter is Not Anticipated By or Obvious In View of Yamaki, et al.

Significantly, Yamaki, et al. fail to disclose or suggest an extender **different from the primary active material**. Rather, Yamaki, et al. disclose a single phase cathode active material that can comprise manganese and copper. Contrary to the Office's assertion, however, this **is not** a disclosure of a cathode having a primary active material **and** an extender **different** from the primary active material. In this regard, Applicants respectfully submit that the Office has misinterpreted Yamaki, et al. Specifically, the Office states that "CuO acts meets [sic] the claim limitations of the 'extender material' and MnO₂ satisfies the 'Active material' limitations." The paragraphs in Yamaki, et al. that specifically refer to CuO and MnO₂ are referring to these species as precursors within a synthesis process used to prepare the lithium-containing composite oxide. A person having ordinary skill in the art, when reading the Yamaki, et al. reference, would readily understand that Yamaki, et al. do not disclose MnO₂ as a primary active material and do not disclose CuO as the extender. Rather, a person having ordinary skill in the art would readily understand that the cathode active materials disclosed by Yamaki, et al., such as, for example, LiMn_{0.7}Cu_{0.2}Al_{0.1}O₂, are **single phase** materials that do not contain a primary active material and a **separate** extender, different from the primary active material.

As such, Yamaki, et al. **fail to disclose or suggest** an electrochemical cell that contains **each and every element** of

Applicants' claim 1. Accordingly, claim 1 is novel over the Yamaki, et al. reference.

Applicants further submit that there is no motivation to modify the secondary battery of Yamaki, et al. in order to arrive at the electrochemical cell of Applicants' claim 1.

In order for the Office to show a *prima facie* case of obviousness, M.P.E.P. § 2142 requires a clear articulation of the reasons why the claimed invention would have been obvious. Specifically, to reject a claim based on this rationale, the Office must articulate the following: (1) a finding that there was some teaching, suggestion, or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at each and every limitation of the claimed invention; (2) a finding that there was reasonable expectation of success; and (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. Applicants respectfully submit the Office has failed to establish a *prima facie* case of obviousness because each and every element of the claims has not been disclosed or suggested by the cited reference, and/or because there is no motivation to modify the reference in order to achieve the claimed subject matter.

Specifically, as noted above, Yamaki, et al. fail to disclose or suggest an electrochemical cell having an extender different from the primary active material. As such, Yamaki, et al. fail to disclose or suggest each and every element of Applicants' claim 1, as is required for a *prima facie* case of obviousness.

Moreover, there is no reason to modify the secondary lithium battery of Yamaki, et al. in order to arrive at the electrochemical cell of Applicants' claim 1. Specifically, Applicants submit that such motivation to modify Yamaki, et al. is lacking because Yamaki, et al. **do not even comment** on a cathode having a primary active material and an extender **different** from the primary active material. Rather, the Yamaki, et al. reference discloses a cathode active material with a single phase. This is a significant difference, as in Applicants' claim 1, the ability of the extender to have a discharge voltage lower than an initial discharge voltage of the primary active material is due in part to the fact that they are separate entities. In Yamaki, et al., however, there are different metal elements incorporated within the single phase composite oxide that may contribute differently to the discharge of the composite oxide, but the composite oxide will still discharge as a single phase. Significantly, however, these elements **are not** separate and distinct materials, such as is required in Applicants' claim 1. Thus, because the single phase in Yamaki, et al. includes elements that may contribute differently to the discharge of the composite oxide, but the composite oxide still discharges as a single phase, there is no reason or motivation for one having ordinary skill in the art to modify Yamaki, et al. to have a cathode including a primary active material and an extender different from the primary active material. In view thereof, one of ordinary skill in the art would not be motivated to modify the secondary lithium battery of Yamaki, et al. to arrive at the specific electrochemical cell of Applicants' claim 1.

In view of the foregoing, Applicants respectfully submit that the Office has failed to meet its burden in establishing a

prima facie case of obviousness here, because each and every element of claim 1 has not been disclosed or suggested by the cited reference and there is no motivation to modify the cited reference in order to achieve the claimed subject matter. Accordingly, reconsideration of the rejection of claim 1 is respectfully requested.

Claims 2, 4, 7, 8, 12-16, 19, 24, 27, 29-31, 38, 41 and 42 depend from claim 1 and are thus patentable over the Yamaki, et al. reference for the same reasons set forth above with respect to claim 1, as well as for the additional elements they require.

Claim 46 is similar to claim 1 and is thus patentable over the Yamaki, et al. reference for the same reasons set forth above with respect to claim 1, as well as for the additional elements it requires.

Claims 47, 49, 51, 52, 56, 59 and 64 depend from claim 46 and are thus patentable over the Yamaki, et al. reference for the same reasons set forth above with respect to claim 46, as well as for the additional elements they require.

Claim 164 is similar to claim 1 and further requires an anode having a capacity of at least 0.5 Ah per cubic centimeter of cell internal volume. Yamaki, et al. fail to disclose or suggest an anode having the claimed capacity required in claim 164. Rather, Yamaki, et al. disclose various capacities of the single phase cathode active material, which **is not** a disclosure or suggestion of the cell internal volume capacity of an anode. As such, the Yamaki, et al. reference fails to disclose each and every element of Applicants' claim 164. Further, there is no reason or motivation to modify Yamaki, et al. to include an anode having a capacity of at least 0.5 Ah per cubic centimeter of cell internal volume because Yamaki, et al. **never even comment** on an anode capacity, let alone a cell internal volume.

Accordingly, claim 164 is patentable over the Yamaki, et al. reference.

IV. 35 U.S.C. 103(a) Rejections

Reconsideration is requested of the rejection under 35 U.S.C. § 103(a) of claim 45 as being unpatentable over Yamaki, et al. in view of Nanjundaswamy, et al. (U.S. 2003/0211392).

The Claimed Subject Matter Is Not Obvious Over Yamaki, et al. in View of Nanjundaswamy, et al.

Claim 45 depends directly from claim 1, which is discussed above. In the interests of brevity, the details and comments set forth above with respect to claim 1, as well as Yamaki, et al., will not be repeated here.

As noted above, Yamaki, et al. fail to disclose or suggest each and every element of Applicants' claim 1. Further, as Yamaki, et al. have a completely different cathode material, there is no reason or motivation to modify Yamaki, et al. in order to arrive at the specific electrochemical cell of Applicants' claim 1.

Nanjundaswamy, et al. disclose a primary lithium cell having an anode comprising lithium and a cathode comprising electrochemically active material selected from silver copper oxides having the formula AgCuO_2 or $\text{Ag}_2\text{Cu}_2\text{O}_3$. The cathode can further include manganese dioxide in admixture with the silver copper oxides.

Significantly, however, the combination of cited references fails to disclose or suggest an extender different from the primary active material, wherein the extender has a discharge

voltage lower than an initial discharge voltage of the primary active material. In fact, as noted in Applicants' previously submitted Amendment C, Nanjundaswamy, et al. actually disclose an extender having a discharge voltage **higher than** that of the primary active material. As such, one having ordinary skill in the art would not be motivated to look to combine Yamaki, et al. with Nanjundaswamy, et al. in order arrive at the specific electrochemical cell of Applicants' claim 1.

Accordingly, claim 45, which depends from claim 1, is patentable over the combination of cited references.

CONCLUSION

In view of the foregoing, Applicants request favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge any fees in connection with this Letter to Deposit Account Number 01-2384 in the name of ARMSTRONG TEASDALE LLP.

Respectfully submitted,

/Christopher M. Goff/

Christopher M. Goff, Reg. No. 41,785
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102
314-621-5070

CMG/DEA/JMH